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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,256	11/02/2001	Kazuaki Watanabe	U 013698-2	8327
7590	11/29/2007		EXAMINER	
Ladas & Parry 26 West 61 Street New York, NY 10023			MCCLENDON, SANZA L	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			11/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/001,256	WATANABE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Sanza L. McClendon	1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 September 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 4 and 5 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 4 and 5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Please note that the examiner of record has changed. The new examiner is Sanza McClendon.

### ***Response to Amendment***

2. In response to the Amendment received on September 4, 2007, the examiner has carefully considered the amendments. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claim 4-5 are rendered moot in view of applicant's remarks and has hereby been withdrawn for consideration.

### ***Response to Arguments***

3. Applicant's arguments, see Remarks/Amendment, filed September 4, 2007, with respect to claims 4-5 have been fully considered and are persuasive in part. The rejection of claim 4 under 35 USC 103 (a) as being unpatentable over JP 11/217525 in view of Sano et al (5,769,930) has been withdrawn, as well as the rejection of claim 5 over JP 11-217525 in view of Sano et al in further view of EP 892024. JP 11-217525 fails to teach non-diene based sulfonyl groups containing (co)polymer and Sano et al and EP 892024 fails to remedy the deficiencies of the primary reference. The rejection of claim 4 under 35 USC 103(a) as being unpatentable over Ota et al has been withdrawn, as well as, the rejection of claim 5 over Ota et al in further view of EP 892024 has been withdrawn. Applicant has successfully invoked 35 USC 103(c) by providing in writing that the instant invention and the reference were commonly owned at the time of invention. The rejection of claims 4-5 under 35 USC 103(a) as being unpatentable over Kurabayashi et al in view of Sano et al has been withdrawn.

4. Applicant's arguments filed September 4, 2007 have been fully considered but they are not persuasive. The rejection of claim 4 under 35 USC 102(a) as being anticipated by WO 01/48100 still stands. Applicant appears to be relying on an English language translation of their first priority document, which the examiner is assuming is JP 2000-335969 since it is not found in the remarks, to overcome the rejection. However, while applicant's state in the remarks that said document has been sent, it is not found in the application file. Instead a listing of patent number from a USPTO data base search (pp. 1-3) was found at the end of applicant's remark section. Clarification is requested. Since applicant has failed to remark/discuss the differences between WO 01/48100 and the instant invention, the examiner assumes there are none and thus the rejection still stands. Additionally, the rejection of claim 5 under 35 USC 103(a) as being unpatentable over WO 01/48100 in view of EP 892024 still stands. It appears applicant relying on the filing date of the 1<sup>st</sup> foreign priority document (see above), however applicant has failed to

submit an English language translation, as well as, not providing remark/discuss the differences between the WO 01/48100 combination and the instant invention the rejection still stands.

5. The rejection of claim 4 as being unpatentable over Nguyen et al (5,990,202) in view of Sano et al (5,769,930) still stands, as well as the rejection of claim 5 over Nguyen et al in view of Sano et al in further view of EP 892024. Applicant appears to be arguing that the primary reference does not teach that said sulfonyl group-containing (co) polymer is not present in the form of an emulsion. The examiner directs applicant attention to column 22, lines 39-42, which states said primer particles (those reading on applicant's group-containing (co) polymer) can be in the form of a polymer suspension, which is likened to an polymer emulsion, therefore the rejection still stands.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claim 4 is rejected under 35 U.S.C. 102(a) as being anticipated by WO 01/48100.
8. The discussion of the disclosure of the prior art WO 01/48100 can be found in the office action dated 3/14/2007 is incorporated herein by reference.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/48100 in view of EP 892024.
11. The discussion of the disclosure of the prior art WO 01/48100 can be found in the office action dated 3/14/2007 is incorporated herein by reference.
12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al (5,992,202) in view of Sano et al (5,769,930).
13. The discussion of the disclosure of the prior art Nguyen et al (5,992,202) can be found in the office action dated 3/14/2007 is incorporated herein by reference.
14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al (5,992,202) in view of Sano et al in further view of EP 892024.
15. The discussion of the disclosure of the prior art Nguyen et al (5,992,202) can be found in the office action dated 3/14/2007 is incorporated herein by reference.

**Conclusion**

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sanza L. McClendon

Examiner

Art Unit 1796

SMc